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EXAMINER LEWIS, CHERYL RENE A	
ART UNIT 2167	PAPER NUMBER

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/823,461

Applicant(s)

PETERS ET AL.

Examiner

Cheryl Lewis

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/13/04 & 2/22/05.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-40 are presented for examination.

### INFORMATION DISCLOSURE STATEMENT

2. The information disclosure statements filed on February 22, 2005 and April 13, 2004, complies with the provisions of MPEP § 609. They have been placed in the application file, and the information referred to therein has been considered as to the merits.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 19 and 33-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

Claims 1, 19, and 33-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they

Art Unit: 2167

fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claims 1, 19, and 33 are software claims having an algorithm. The algorithm comprises a plurality instruction code and/or instruction statements defined in the claim limitations as binding statements. The result of the data binding engine produces a series of binding statements.

As to claims 33-40, these claims are further rejected under 101 because they recite a computer-readable medium. The medium as defined in the specification may

Art Unit: 2167

suggest the computer-readable medium corresponds to any of the possible media including non tangible media such as transmission media including carrier waves or signals and for these reasons these claims do not have results which are useful and concrete. Thus, claims 33-40 are computer-readable medium claims that require a physical component. The examiner suggests the use of claim language "computer-readable storage device" in an effort to clarify that the claims comprise physical media.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 19, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 19, and 33 recite a series of binding statements. These statements are executable statements that belong to an algorithm. The series of statements are not producing any concrete and useful results within the "computer" technological art.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2167

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Liang (Publication No.: US 2005/0160107 A1 filed December 28, 2004, priority to provisional application no. 60/533,205, filed on December 29, 2003).

9. Regarding Claim 1, Liang teaches an advanced search, file system, and intelligent assistant agent.

The method and associated system for an advanced search, file system, and intelligent assistant agent as taught or suggested by Liang includes:

a data binding engine (paragraph 0055, 'categorization engine', paragraph 0060, 'search engine', paragraph 0061, 'keyword extraction engine') that receives a plurality of binding statements (paragraph 0060, '... "automobile", "service", and combinations such as "Jaguar car service" ...'), the binding statements comprising a first and second binding statement (paragraph 0063, 'FIG. 3 illustrates an exemplary user interface for presenting categorization of search results where the categories are dependent of the keywords used in the search...', 'In FIG. 2, subcategory A 308 of category A has the highest number of pages or highest ranking based on keywords or concept matches, and the titles and summaries of these pages 320 in this subcategory 308 can be displayed. The other categories 305 and 306 and other subcategories of category A 310 and 312 can be displayed as index tabs. When the user clicks on a category tab, pages in that category and/or its subcategories can be displayed.').

Art Unit: 2167

10. Regarding Claim 2, Liang teaches each statement of the plurality of binding statements is associated with an execution priority (paragraph 0055, 'hierarchy of categories').

11. Regarding Claim 3, Liang teaches priority is indicated by a sequence of the plurality of binding statements (paragraph 0055, 'hierarchy of categories').

12. Regarding Claim 4, Liang teaches a first and second binding statement is associated with a second priority (paragraph 0055, 'hierarchy of categories').

13. Regarding Claim 5, Liang teaches the first priority is higher than the second priority; the first binding statement is evaluated (paragraph 0055, 'hierarchy of categories').

14. Regarding Claim 6, Liang teaches the first binding statement evaluates successfully, the first binding statement is executed (paragraph 0055, 'hierarchy of categories').

15. Regarding Claim 7, Liang teaches the first priority is a highest priority and second priority is a next highest priority and the first binding statement does not evaluate success fully the second binding statement evaluates successfully executing the second binding statement (paragraph 0055, 'hierarchy of categories').

16. Regarding Claim 8, Liang teaches a data source (figure 3).

9.Regarding Claim 9, Liang teaches an object accessed via a URI (figure 3, element 320).

17. Regarding Claim 10, Liang teaches an XML source (figure 3).

Art Unit: 2167

18. Regarding Claim 11, Liang teaches the data source comprises an object model (figure 3).

19. Regarding Claim 12, Liang teaches a database query language (paragraph 0052).

20. Regarding Claim 13, Liang teaches a binding path (paragraphs 0115-0117).

21. Regarding Claim 14, Liang teaches an XML Xpath (paragraphs 0115-0117).

22. Regarding Claim 15, Liang teaches an object path (paragraphs 0115-0117).

23. Regarding Claim 16, Liang teaches an expression (paragraphs 0115-0117).

24. Regarding Claim 17, Liang teaches the first binding statement evaluates successfully comprises determining that the expression evaluates to true (paragraphs 0115-0117).

25. Regarding Claim 18, Liang teaches a default value and the default value is to update a target when the second binding statements evaluates successfully (paragraphs 0115-0117).

26. Regarding Claim 19, Liang teaches receiving a plurality of binding statements comprises a first and second binding statement (paragraph 0063, 'FIG. 3 illustrates an exemplary user interface for presenting categorization of search results where the categories are dependent of the keywords used in the search...', 'In FIG. 2, subcategory A 308 of category A has the highest number of pages or highest ranking based on keywords or concept matches, and the titles and summaries of these pages 320 in this subcategory 308 can be displayed. The other categories 305 and 306 and other subcategories of category A 310 and 312 can be displayed as index tabs. When the

Art Unit: 2167

user clicks on a category tab, pages in that category and/or its subcategories can be displayed. '); receiving a priority order indicating an order of execution of the binding statements (paragraph 0055, 'hierarchy of categories'), the first binding statement associated with a highest priority and a second binding statement associated with a next highest priority (paragraph 0055, 'hierarchy of categories'); and executing the first binding statement (paragraph 0055, 'hierarchy of categories').

27. Regarding Claims 20-29 and 31-40, the limitations of these claims have been noted in the rejections of claims 1-19 presented above. They are therefore rejected as set forth above.

28. Regarding Claim 30, Liang teaches a user interface (figure 1, element 121).

#### **NAME OF CONTACT**

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Art Unit: 2167

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Cheryl Lewis". The signature is fluid and cursive, with the first name "Cheryl" and last name "Lewis" clearly distinguishable.

Cheryl Lewis  
Patent Examiner  
September 29, 2006